

REMARKS

Claims 1, 2, 4, 5, and 7-14 are pending. Claims 12 and 13 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1, 2, 4, 5, and 7-14 are rejected under 35 U.S.C. § 103(a). Each of these rejections is addressed below.

Claim amendment

Claim 12 is canceled. Claim 1 is amended to recite the phrase “said optical device comprises a wide-angle lens.” Support for this amendment is found throughout the specification, for example, at page 4, line 32 through page 5, line 2. Claim 9 is amended so that its language corresponds to amended claim 1. Claim 13 is amended to recite “wherein said flat element is a single flat element.” Support for this change is found through the specification, for example, in Figure 1.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 12 and 13 are rejected, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention and failing to further limit the subject matter of independent claim 1. The rejection of claim 12 has been rendered moot by the cancellation of this claim. Claim 13 is amended to recite “wherein said flat element is a single flat element,” thereby limiting independent claim 1 further. Applicant submits that claim 13, as amended, is free of the basis for this rejection.

Rejection under 35 U.S.C. § 103(a)

Claims 1, 2, 4, 5, and 7, 8, 10-14 are rejected under 35 U.S.C. § 103(a), over Sakamoto (U.S. Patent No. 6,095,972) in view of Bullard (U.S. Patent No. 5,665,052). Claim 9 is further rejected under 35 U.S.C. § 103(a), over Sakamoto in view of Bullard and further in view of Rothfels (U.S. Patent No. 5,873,818). Applicant traverses this rejection as it applies to amended claim 1 and its dependent claims 2, 4, 5, 7-11, 13, and 14 (claim 12 has been cancelled).

For a rejection under 35 U.S.C. § 103(a) over a combination of references, three basic criteria must be met. First there must be a suggestion or motivation to combine references. Second, there must be a reasonable expectation of success. Third, the reference or references must teach or suggest all claim limitations (MPEP 2143).

As noted above, claim 1 is amended to incorporate an optical device comprising a wide-angle lens, thus incorporating this feature into all claims that depend from claim 1. The combination of Sakamoto in view of Bullard does not teach or suggest such a wide angle lens, and thus does not teach or suggest all claim limitations of amended claim 1 or its dependent claims 2, 4, 5, 7-11, 13, and 14. As a wide-angle lens is required by amended claim 1, the rejection of claims 1, 2, 4, 5, 7-11, 13 and 14 as being obvious over Sakamoto and Bullard may be withdrawn.

Claim 9 was further rejected under 35 U.S.C. § 103(a) over Sakamoto in view of Bullard and Rothfels. The limitation of a wide-angle lens, previously present only in claim 9, is incorporated in claim 1, and therefore all claims that depend from claim 1.

While elements of the presently claimed invention may be found in the prior art, it is required that the prior art suggests the desirability of combining the references in such a way as to arrive at the presently claimed invention. *In re Gordon* 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *In re Mills* 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). In the present case, as discussed below, that desirability is lacking.

Rothfels teaches (column 2, line 65 through column 3, line 3):

A hollow tube 52 affixed to the blade portion base 36 has the eyepiece lens 48 received in one end and the prism-lens 50 in the other end. The tube 52 may be separately constructed and suitable secured to the base 36. Alternatively, the tube and base 36 may be constructed unitarily from metal or plastic (e.g., injection molding).

If anything, a skilled person combining the permanently affixed prism-lens (i.e., a type of wild-angle lens) of Rothfels with the laryngoscope shown in Bullard would be motivated to integrate the wide-angle lens in the fixed optical device that includes channels 38 and 40 of Bullard, as Rothfels does not teach or suggest a removable optical apparatus. Such a hypothetical optical device would not be removable from the laryngoscope, as is presently claimed. This rejection should therefore be withdrawn.

CONCLUSION

Applicant submits that the claims are in condition for allowance, and such action is respectfully requested. Enclosed is a Petition to extend the period for replying to the Office Action for one (1) month, to and including May 18, 2005, and a check in payment

of the required extension fee.

If there are any additional charges or any credits, please apply them to Deposit
Account No. 03-2095.

Respectfully submitted,

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